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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,534	11/14/2003	Earl Cully		9307

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EXAMINER

BELL, KENT L

ART UNIT PAPER NUMBER

1661

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,534

Applicant(s)

CULLY, EARL

Examiner

Kent L. Bell

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- application filed 11/14/03*
- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/14/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: PTO/SB/03

K. L. Bell

Detailed Action

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

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In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 1, lines 1-3, should be deleted as this information would be more properly placed on a cover sheet rather than the first page of the specification. Rather than setting forth this information here, applicant should set forth the title of the invention, centered like the three lines already present, i.e. Pond Cypress Tree Named 'Morris'.

B. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c)(4)(5) and 37 CFR 1.163(d). This

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information should be set forth before the “Background of the Invention” section as set forth in 37 CFR 1.163(c).

C. Page 1, lines 11-22, Applicant states the instant plant is the result of a “scion” taken from a pond cypress tree. The origin of the instant tree is uncertain. It is not clear which tree applicant is intending the invention to be, i.e. the tree at the Morris Arboretum or the tree created from grafting the scion taken from the tree at the Morris Arboretum. If the scion was taken from the pond cypress at the Morris Arboretum then the tree being patented would be the tree at the Morris Arboretum. If the scion was naturally or an induced mutated and that is why the scion was given to the inventor then the instant plant once grown out from grafting would be the instant invention. The origin of the tree should be clearly and unambiguously set forth in the specification.

D. Page 1, line 16, Applicant should set forth in the specification the location where the tree was asexually reproduced (MPEP 1605, 37 CFR 1.163(a)).

E. Page 1, line 18, Applicant should set forth in the specification the manner in which the instant tree was asexually reproduced (MPEP 1605, 37 CFR 1.163(a)).

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F. Page 1, lines 19 and 20, Applicant should either italicize or underline “*Taxodium ascendens*” as this is the proper way to set forth a Genus and species designation.

G. Page 1, lines 21 and 22, Applicant states “ ‘Prairie Sentinel’ ” has been patented. Applicant is requested to set forth in the specification the Patent number, i.e. U.S. Plant Patent number, if the instant plant was patented as a Plant Patent or simply the U.S. Patent number if patented as a utility patent.

H. Page 1, line 33, Applicant states “ ‘Prairie Sentinel’ ” was introduced in 1973. However, applicant previously states the tree was introduced under patent in 1974, line 22. It is not clear whether the introduction under patent is different than the introduction not under patent. Correction and/or clarification is necessary.

I. Page 2, line 1, Applicant refers to “Interstate 72”. This recitation is vague as the location of this interstate may not be known to others and doesn’t really set forth any quantifying information. A USDA hardiness zone would be more appropriate. Applicant should set forth in the specification a USDA hardiness zone for the instant tree as to be more specific regarding the plant’s hardiness.

Detailed Action

J. Page 2, line 7, “at Heritage Trees, Inc.” should be deleted as this constitutes unwarranted advertising (MPEP 1610).

K. Page 2, lines 8 and 9, Applicant states “Asexual propagation by this method has proven to be very consistent and effective.”. However, this does not mean the instant tree reproduces true to type. The instant tree must be stable and the tree’s characteristics must reproduce exactly the same as the initially discovered tree in successive generations of asexual propagation in order to obtain a U.S. Plant Patent. If such is accurate then applicant should set forth in the specification --Asexual reproduction by grafting has shown that the unique features of this new Pond Cypress are stable and reproduced true to type in successive generations.--.

L. Page 2, lines 13-15, “The” through “61455” should be deleted as this recitation may cause confusion regarding inventorship. Further, it is not necessary to state who prepared the taxonomic description.

M. Applicant should set forth in the specification the age of the tree when described and location of culture.

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N. Applicant should set forth in the specification information relative to the instant tree's trunk including the typical and observed trunk diameter at a specified height above the ground.

O. Page 3, lines 9 and 11, Applicant sets forth a size but does not state whether the size is for length, diameter, or something else. Applicant should set forth in the specification the typical and observed branch length and diameter.

P. Applicant should set forth in the specification information relative to the instant tree's branchlets including the typical and observed branchlet length, width, and coloration with reference to the employed color chart.

Q. Page 3, lines 14-22, Applicant describes scales and foliage. However, it is uncertain if applicant is describing the instant tree's needles. Applicant should verify whether or not applicant intends the scales to be needles. Applicant should set forth in the specification information relative to the instant tree's needles including the typical and observed shape, length, diameter/width, apex, margin, and base descriptors, and coloration with reference to the employed color chart.

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R. Page 3, line 22, Applicant should set forth in the specification whether the coloration set forth for the leaves is for the upper, lower, or both surfaces. Further, applicant should set forth in the specification fall coloration with reference to the employed color chart.

S. Page 3, lines 23-25, Applicant should delete these lines as these recitations are unnecessary as the instant tree does not possess these characteristics.

T. Page 3, line 26, Applicant should set forth in the specification additional information relative to the instant tree's vegetative buds including the typical and observed coloration with reference to the employed color chart, if readily available.

U. Page 3, lines 29 and 30, Applicant should set forth in the specification additional information relative to the instant tree's male flowers including the typical and observed diameter and coloration with reference to the employed color chart.

V. Applicant should set forth in the specification information relative to the instant tree's female flowers, if produced, including the typical and observed amount, shape, length, diameter, and coloration with reference to the employed color chart.

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W. Page 3, line 34, Applicant states “green” and “brown”. Applicant should set forth in the specification a color designation for the “green” and “brown” colorations with reference to the employed color chart. The recitations “green” and “brown” are vague and insufficient in these instances.

X. Page 4, lines 1-11, Applicant should delete these lines. Lines 1-3 should be set forth in the response to this office action. The information set forth at lines 5 and 6 is pretty much set forth at lines 12-19 of the same page. Lines 8-11 can be rewritten as --Comparison and usage--.

Y. Page 4, lines 21-30 should be deleted as the inventor’s name and address has been previously set forth on the Declaration. The assignment has been set forth on the small entity paper.

Z. Applicant should place a period at the end of the abstract.

AA. Applicant filed a declaration which is suppose to be used in conjunction with an application data sheet. Applicant should provide the data sheet or use the appropriate U.S. Plant Patent Declaration (PTO/SB/03), attached. Preferably applicant should fill out the attached declaration and submit when submitting response to this Office action.

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The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

K. L. Bell

**KENT BELL
PRIMARY EXAMINER**

